

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES**

Applicants : Koichi NAGOSHI et al. Confirmation No.: 3984
Appln. No. : 10/663,688 Examiner: S. Muhebbullah
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For : MULTIFUNCTION APPARATUS HAVING AT LEAST A
COPYING FUNCTION, SERVER, SERVER
SYSTEM, AND METHOD FOR CONTROLLING
MULTIFUNCTION APPARATUS (as amended)

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37(d)

Further to the Notice of Appeal dated August 8, 2008 of twice rejected claims including the rejections set forth in the outstanding Office Action, this Appeal Brief under 37 C.F.R. § 41.37(d) is responsive to the Final Office Action mailed April 8, 2008 and the previous Office Action dated September 24, 2007, in which the Examiner rejected claims 28, 29, 36-48 and 55-63. Inasmuch as the filing date of the Notice sets a two-month shortened statutory period for filing of the Appeal Brief to expire on October 8, 2008, this Appeal Brief is timely filed.

Application No. 10/663,688
Attorney Docket No.: P23994
Appeal Brief Under 37 C.F.R. § 41.37(d)

If for any reason any extension of time and/or any fee is required to maintain the pendency of the present application, including any extension of time and/or appeal fee, authorization is hereby provided to charge any required fee, including any fee for the Appeal Brief and any necessary extension of time fee to Deposit Account No. 19-0089.

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Whether claims 28, 29, 36-48 and 55-63 are unpatentable under 35 U.S.C. § 103(a) over KITADA in view of TANIMOTO

- 1. Independent claims 28 and 55 and dependent claims 37-40, 45 and 57-59 are not disclosed, suggested, or rendered obvious by KITADA in view of TANIMOTO**
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I. Real Party In Interest

The assignee, Panasonic Communications Co., Ltd. of Tokyo, Japan,
is the real party in interest.

II. Related Appeals and Interferences

None.

III. Status of Claims

Claims 28, 29, 36-48 and 55-63 are pending in this application.

The pending Claims stand twice rejected. Appellant appeals the rejection of claims 28, 29, 36-48 and 55-63. In accordance with 37 C.F.R. § 41.37(c)(viii), the claims on appeal are included in the claim appendix.

Claims 1-27, 30-35, and 49-54 have been cancelled.

IV. Status of Amendments

There are no amendments that have not been entered. The Response under 37 C.F.R. § 1.116 filed July 8, 2008, did not include any claim amendments. The claims are in their form as amended in the Amendment filed December 26, 2007.

V. Summary of Claimed Subject Matter

The following description is made with respect to the independent claims and includes reference to particular parts of the specification. As such, the following is merely exemplary and is not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods within the scope of the claims.

The present invention, as embodied in claim 28, relates to a multifunction apparatus having at least a scanning function and not having a facsimile transmission function [0051]. The multifunction apparatus is connected with a server via a network [0013]. The server storing information regarding a menu [0052], the menu being displayable on the multifunction apparatus [0056]. The multifunction apparatus includes a scanner configured to scan a document [0013], a panel configured to display a menu representing functions of the multifunction apparatus [0013], and a controller configured to communicate with the server, to receive the information regarding the menu from the server, and to display a menu on the panel based on the information regarding the menu received from the server [0029]-[0032], [0056]. The controller is further configured to send, to

the server, based on the information regarding the menu, scanned image data with predetermined information [0057] indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission [0058], when a predetermined menu indicating a facsimile transmission function is displayed on the panel of the multifunction apparatus, the information regarding the menu including the predetermined menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the predetermined menu [0057]. Thus, the server transmits, to the another multifunction apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another multifunction apparatus [0059].

The present invention, as embodied in claim 55, relates to a method for controlling a multifunction apparatus. The multifunction apparatus has at least a scanning function and does not have a facsimile transmission function [0051], the multifunction apparatus being connected with a server via a network [0013]. The server storing information regarding a menu [0052], the menu being displayable on the multifunction apparatus [0053],

the multifunction apparatus having a scanner that scans a document, and a panel that displays a menu representing functions of the multifunction apparatus [0013]. The method includes communicating with the server, to receive the information regarding the menu from the server [0029], displaying a menu on the panel based on the information regarding the menu received from the server [0032], and sending, to the server, based on the information regarding the menu, scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission [0057] and [0058], when a predetermined menu indicating a facsimile transmission function is displayed on the panel of the multifunction apparatus, the information regarding the menu including the predetermined menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the predetermined menu [0057], the server transmits, to the another multifunction apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another multifunction apparatus [0059].

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 28, 29, 36-48 and 55-63 are unpatentable under 35 U.S.C. § 103(a) over KITADA et al. (U.S. Patent Application Publication No. 2004/0024811, hereinafter “KITADA”) in view of TANIMOTO (U.S. Patent No. 6,885,469, hereinafter “TANIMOTO”).

VII. Arguments

Whether claims 28, 29, 36-48 and 55-63 are unpatentable under 35 U.S.C. § 103(a) over KITADA in view of TANIMOTO.

- 1. Independent claims 28 and 55 as well as dependent claims 37-40, 45 and 57-59 are not disclosed, suggested, or rendered obvious by KITADA in view of TANIMOTO**

The present invention is defined by independent apparatus claim 28 and corresponding independent method claim 55. In order to simplify and streamline the following arguments, reference will be made to the language and terminology of apparatus claim 28. Corresponding arguments apply to method claim 55 which contains substantially corresponding method terminology.

The present invention is directed to a multifunction apparatus, and in particular, to a multifunction apparatus which does not have a facsimile transmission function. It is an objective and purpose of the present invention to enable the transmission of a facsimile message by such apparatus, which does not have it's own facsimile transmission function, by partnering with another multifunction apparatus which does have such a facsimile transmission function. The multifunction apparatus of the present invention, which does not have a facsimile transmission function, partners with and

utilizes as a proxy, the facsimile transmission capability or functionality of another multifunction apparatus, to transmit the data from the multifunction apparatus that does not have a facsimile transmission function, to the multifunction apparatus that does have a facsimile transmission function and then, by facsimile transmission, to the ultimate recipient of the data. The present invention thus solves the problem of sending data, by facsimile transmission, from a multifunction apparatus that does not have a facsimile transmission function, to a recipient that may have only a facsimile reception capability.

Neither of the prior art references of record address the problem of how a multifunction apparatus, that does not have a facsimile transmission capability can transmit data to a recipient that has a facsimile reception capability. Further, neither of the two references relied upon by the Examiner in the outstanding rejection, even if combined as proposed by the Examiner, provide a solution for the above problem and certainly they do not disclose, teach, or render obvious the particular solution provided by the Applicants as set forth in the independent claims of the present application.

In setting forth the rejection, the Examiner relied upon paragraph 0023, lines 15 - 16 to support his position that KITADA discloses a multifunction apparatus not having a facsimile transmission function.

However in that paragraph, KITADA merely indicates that a multifunction device (MFD) may or may not contain various functionalities. However, Applicants do not dispute that there are multifunction apparatuses that do not contain a facsimile transmission function. In fact Applicants invention is directed to solving the problem resulting from just such a shortcoming. However, the particular multifunction apparatus or device disclosed by KITADA clearly relates to a multifunction device that includes a facsimile transmission function. In fact, figure 5 shows a main menu that is displayed on the touch-sensitive LCD screen and that is used to request faxing of a document (paragraph [0043] lines 11 - 13 and paragraph [0047] lines 1 and 2).

The Examiner's reference to the last three lines of paragraph [0023] relate to the embodiment disclosed in figures 9 and 10. However, to the extent that the multifunction device of this embodiment does not contain a facsimile transmission function, it appears to be unable to effect or cause the transmission of a facsimile. This is in direct contrast with the multifunction apparatus defined in the pending claims, which, although it does not have a facsimile transmission function or capability, is enabled to transmit a facsimile by partnering with another multifunction apparatus that does have such a facsimile transmission capability.

As noted above, the multifunction apparatus or device of KITADA, particularly as described in the first embodiment thereof, clearly has a facsimile transmission capability. Utilizing figure 5 as an example, KITADA transmits a fax in the ordinary and conventional fashion by entering the fax number of one or a plurality of recipients and transmitting the facsimile to the recipient(s), as disclosed at paragraph [0048], lines 16-18.

To carry out a facsimile transmission, the multifunction device of KITADA utilizes a fax server, just as in carrying out a scanning function, a scan server is utilized. Accordingly, it is additionally inconsistent for the Examiner to assert that the multifunction apparatus of KITADA provides a scanning function (as required by the claim language) but does not provide a facsimile transmission function. Similarly, the Examiners explanation, in the Advisory Action of July 31, 2008, that another multifunction device is the fax server is inappropriate. KITADA discloses multifunction devices 10, 20, and 30. The fax server 80 is not a multifunction device but a server and cannot reasonably be considered to be a multifunction device, particularly where, as here, KITADA explicitly distinguishes between the multifunction devices 10, 20, and 30 and the fax server 80.

In other words KITADA merely discloses that although there are in existence multifunction devices that do not have facsimile transmission

capabilities, the disclosure thereof relates to and deals with a multifunction device that clearly has a facsimile transmission function. This facsimile transmission capability of the MFD of KITADA is clearly and explicitly evidenced by paragraph [0030] wherein KITADA discloses that certain functions of the MEDS 10-30, "such as copying and direct e-mail and faxing can be accessible to a user that is not domain authenticated." Similarly, at paragraph [0022], KITADA discloses that a scanned document can be faxed from the scanning device (i.e., from MFDs 10-30). Such facsimile transmission is thus clearly a provided capability of the MFDs 10-30 and thus does not require a partnership between the multifunction apparatus that does not have a facsimile transmission capability with another multifunction apparatus that does have a facsimile transmission capability, as recited in Applicants pending claims.

Yet further, KITADA explicitly discloses that the multifunction apparatus has a facsimile transmission function in paragraph [0048], starting at line 16, wherein, upon touching the "OK" button, the information received via the screen 500 "can be processed by the MFD to fax the document".

Thus, there can really not be any dispute that the multifunction device disclosed by KITADA has a facsimile transmission function and it thus has no need to utilize facsimile transmission capability of another multifunction

apparatus to transmit a facsimile to a recipient. In other words, there is no logical reason, based on the capabilities of the KITADA multifunction device for utilizing "another multifunction apparatus" as set forth in the present claims. For this reason alone Applicants claims are patentable over KITADA in view of TANIMOTO.

Applicants' claims additionally recite a controller that is configured to send, to the server, the scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function. Addressing this feature of Applicants' claims, the Examiner directs attention to paragraphs [0026], [0047] and [0048] of KITADA. However none of these paragraphs contain any disclosure related to "predetermined information indicating another facsimile apparatus having a facsimile transmission function.

Paragraph [0026] discloses that the scan server 40 receives the scanned document and selected addresses numbers from the MFD 20 and routes the scanned document to the appropriate server. However, the "selected addresses/numbers" refer to the e-mail addresses and/or fax numbers discussed in the preceding two paragraphs that are obtained from the directory server. Thus, there is no sending of "scanned image data with predetermined information indicating another multifunction apparatus

having a facsimile transmission function" as recited by the pending claims.

The fax number disclosed in the preceding two paragraphs refers to the fax number of the ultimate recipient of the document data and does not refer to another (i.e., intermediate) multifunction apparatus having a facsimile transmission function.

Paragraphs [0047] and [0048] describe the procedure by which a facsimile (or an e-mail) is transmitted. Neither of these paragraphs disclose sending, to the server, predetermined information indicating another multifunction apparatus having a facsimile transmission function. Rather, by following the procedures set forth in these two paragraphs, upon touching the "OK" button 535, the MFD transmits the document by facsimile to the appropriate fax number (paragraph [0047], line 11). The "information received by the screen 500" in paragraph [0048], refers to the various buttons and numbered portions shown in figure 5, none of which relate to "predetermined information indicating another multifunction apparatus having a facsimile transmission function". Accordingly, none of the paragraphs cited by the Examiner contain a disclosure that teaches this feature as recited in Applicants claim. Rather, these paragraphs merely disclose the ordinary and conventional manner of scanning and faxing scanned material by a multifunction apparatus that has a facsimile

transmission capability of its own and accordingly these paragraphs are of little relevance to Applicants claims, which explicitly relate to a multifunction apparatus that does not have a facsimile transmission function. For this additional reason Applicants claims are submitted to be patentable over KITADA in view of TANIMOTO.

In response to Applicants' previous assertions that KITADA does not disclose sending scanned image data together with "predetermined information indicating another multifunction apparatus", the Examiner responds (in the Advisory Action dated July 31, 2008) by relying on paragraph 0033 and asserting that the "users profile indicates the fax server the fax documents are to be sent to along with the fax number of the recipient fax device the document is to be eventually sent to." It is respectfully submitted that the Examiner has misinterpreted the users profile disclosed in paragraph [0033] of KITADA. In particular, the specific profiles set by the scan server 40 refer to features of a specific MFD. In other words, the profiles are of the transmitting device rather than of a receiving device having a facsimile transmission function. While the parameters set by the MFD profiler can "relate to" the fax server 80, this still does not constitute sending, to the server, based on the information regarding the menu, scanned image data with predetermined information indicating

another multifunction apparatus having a facsimile transmission function, as recited in Applicants claim. Moreover, there is no indication whatsoever that the parameter which might “relate to” the fax server is transmitted to the server along with the scanned image data. Nor is there any logical reason why one should expect the parameter, which appears to relate to features of the server, be transmitted with any particular data.

Nor does Paragraph [0026] (also referenced by the Examiner in the Advisory Action) contain any disclosure regarding sending, to the server, scanned image data together with predetermined information indicating another multifunction apparatus having a facsimile transmission function, as previously discussed.

In setting forth the rejection, the Examiner admitted that “KITADA does not teach the another apparatus to be a multifunction apparatus and transmitting the image data to a receiving apparatus by facsimile transmission.” Thus, the Examiner relied on the teachings of TANIMOTO for this admittedly missing feature. However, the teachings of TANIMOTO are rather remote from KITADA, and there is no logical reason for combining the teachings of TANIMOTO with the disclosure of KITADA. Further, even if combined, the disclosures of KITADA and TANIMOTO would not result in Applicants’ recited device.

TANIMOTO relates to an image processing device that detects errors within its functions rather than to a device that is lacking a predetermined function. Moreover, while TANIMOTO deals with facsimile data, the data is transmitted via a LAN 3 as set forth at col. 5, lines 45, 46, and 54 to 56. Furthermore, TANIMOTO does not transmit the data to the originally intended recipient, but reroutes the data to an alternative recipient.

While the examiner relies upon TANIMOTO to teach transmitting the image data to the receiving apparatus by facsimile transmission, this feature is not taught by TANIMOTO. In particular, at column 5, lines 52 through 56, TANIMOTO discloses that the fax data is stored in RAM 15 and the stored message is sent to the forwarding address over LAN 3. Thus, facsimile transmission is not provided therein when an error is detected. Thus, TANIMOTO does not disclose the feature for which the Examiner has relied thereupon and which the Examiner has also admitted to be missing from KITADA.

In the concrete example described by TANIMOTO starting on col. 5, line 25, the fax server 1 detects an error in its own printing unit 17. The managing PC2 then instructs the fax server to send the received facsimile image data to another client PC instead of printing the facsimile image data

out at the local printer. Thus, TANIMOTO does not provide the function containing the error, but rather provides an alternate function.

Thus, the combination of KITADA and TANIMOTO would not result in Applicants invention which transmits facsimile data to an intended recipient, not to an alternate recipient. Moreover, as noted above, TANIMOTO forwards the facsimile image data to a network address of another client (which is input through the keyboard) over the LAN to perform alternative processing for the problem function. In other words the function having a detected error therein is not provided by some other means in the TANIMOTO system but rather alternative processing is provided.

Applicants claims additionally recite that the server transmits, to the another multifunction apparatus (i.e., a multifunction apparatus having the facsimile transmission function) the image data scanned by the multifunction apparatus and that the another multifunction apparatus is capable of transmitting the image data to a receiving apparatus by facsimile transmission. However, as noted above in a TANIMOTO, upon detection of an error, the data is not transmitted by facsimile transmission but rather is transmitted via a LAN.

Applying these teachings of TANIMOTO to the system of KITADA might well result in a system in which, upon detection of an error in a

facsimile transmission, result in disabling of the facsimile capability and transmission of the data, to a different recipient by an alternative processing method, such as by e-mail. This is clearly not what is recited in Applicants' claims. Applicants' claims provide facsimile transmission for a multifunction apparatus that does not have a facsimile transmission capability. The combination of KITADA and TANIMOTO, even if appropriate, would not result in the claimed apparatus or method.

The Examiner's error in combining the teachings of these two references is explicitly set forth in his statement of the rejection (Final Office Action of April 8, 2008, page 3 last three lines) where the Examiner asserts that it would have been obvious combine the teachings of KITADA and TANIMOTO in order to route data to alternate destinations and perform other functions. Applicants' invention as claimed does not operate in the manner of the Examiner's proposed combination. Applicants' invention, as claimed, does not route data to alternate destinations and does not perform other functions. Rather, Applicants' invention provides a not-provided function and routes data to a recipient via facsimile transmission by means of the another facsimile apparatus having a facsimile transmission function.

Moreover, the recited feature of Applicants' claim, that the controller is configured to send, to the server, "scanned image data with predetermined

information indicating another multifunction apparatus having a facsimile transmission function" which, as noted above, is not disclosed by KITADA, is also not disclosed by TANIMOTO. According to the teachings TANIMOTO, once an error is detected, the user must (manually) input commands to disable the printer 17 and to cause the fax server 1 to perform the alternative processing. The user also sets the fax server to forward received fax image data to a network address of another client. Thus, to the extent that there is any predetermined information in TANIMOTO, it is manually and directly entered by the user rather than sent to a server together with the scanned image data.

In addition to the concrete example of TANIMOTO dealing with an error in the printing function, as previously discussed, TANIMOTO also discloses how his system will react to various other error situations. In particular, in the paragraph bridging columns 5 and 6, TANIMOTO indicates that if there is an error in the communication function of the machine (e.g., if the facsimile transmission capability is disabled) then the multifunction device could still be used either as a network scanner or as a printing station. This clearly indicates that TANIMOTO, in direct contrast to the Applicants' claimed invention, does not enable a multifunction apparatus to obtain the

benefit of a function that it does not have, but merely facilitates utilization of the remaining functions. This is clearly remote from Applicants' invention.

Yet further, beginning on page column 6, line 5, TANIMOTO discusses what occurs if there is in error in one of a plurality of communication lines. In this situation the fax server merely utilizes a different line than the one that has a problem. Again, TANIMOTO does not provide a system that supplies a function that is not available, due to error or otherwise, but rather provides an alternative function. This is further evidence of how remote TANIMOTO is from the problem solved by Applicants' claimed invention.

In addition to the above noted shortcomings of the proposed combination of references with respect to the recited features of Applicants' invention, the Examiner's rejection contains additional errors in his characterization of the fax server of KITADA, as comprising the recited "another multifunction apparatus." This is incorrect at least because KITADA provides a number of multifunction devices and a fax server each having specifically defined features and functions. Thus, they are not interchangeable as the Examiner assumes. Yet further, the Examiner equates, without without any support, Applicants recited "not having a facsimile transmission capability" with the operation of the TANIMOTO

device which takes place upon the occurrence of an error in a provided function. This is also incorrect as these two situations are also not interchangeable.

In view of all of the above, Applicants respectfully submit that the combination of KITADA and TANIMOTO is inadequate and insufficient to render unpatentable the combination of features recited in each of Applicants' claims at least because the proposed combination does not disclose a "multifunction apparatus having at least a scanning function and not having a facsimile transmission function", does not disclose sending, to the server, "scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission" and does not disclose transmitting the image data "to a receiving apparatus by facsimile transmission."

Accordingly, in view of the foregoing, Applicants respectfully submit that KITADA and TANIMOTO, in any proper combination, fails to establish a prima facie case of obviousness with respect to independent claims 28 and 55 and thus respectfully request reversal of the outstanding rejection asserted against these claims.

2. Claim 29 is not disclosed, suggested, or rendered obvious by KITADA in view of TANIMOTO.

Applicants note that claim 29 is dependent upon and includes the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claim 29 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 29.

For example, claim 29 additionally recites utilizing a scanning function to scan a document, when the facsimile transmission is selected on a menu. In addressing this feature, the Examiner directs attention to paragraphs 0026, 0047 and 0048. However none of these paragraphs relate to the recited feature of claim 29. Paragraph 0026 deals with routing of documents while paragraphs 0047 and 0048 deal with faxing and e-mailing of documents. Thus neither of these paragraphs disclose scanning a document when the facsimile transmission is selected on the menu.

Accordingly, claim 29 is submitted to be patentable over the asserted combination of references based upon its own recitations as well as based upon as its dependence from a shown to be allowable base claim.

3. Claims 36 and 56 are not disclosed, suggested, or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claims 36 and 56 are dependent upon and include the subject matter recited in claims 28 and 55 from which they respectively depend. Accordingly, the obviousness rejection applied against claims 36 and 56 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claims 28 and 55. Moreover, KITADA and TANIMOTO, in any proper combination, do not teach the combination of features recited in claims 36 and 56.

For example, these claims recite that the information regarding the menu is utilized for the multifunction apparatus and also for another multifunction apparatus. In addressing these features, the Examiner directs attention to Paragraph 0033. However, the cited paragraph of KITADA relates to an MFD profiler and the information contained therein. However, there is no indication whatsoever within the cited portion that the information of the profiler is "information regarding the menu" as that term is defined in base claim 28.

Accordingly, claims 36 and 56 are submitted to be patentable over the proposed combination of references based upon their own recitations as well as based upon their dependence from a shown to be allowable base claim.

4. Claims 41 and 42 are not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claims 41 and 42 are dependant upon and include the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claims 41 and 42 is without an appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to independent claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claims 41 and 42.

For example, each of claims 41 and 42 recite a job ID. In addressing these claims, the Examiner directed Applicants' attention to paragraphs 0039 and 0044 of KITADA. However, neither of these paragraphs contain any disclosure regarding a job ID as recited in Applicants' claims. In this regard, Applicants note that paragraph 0039 mentions various parameters including "a specific user ID". However a user ID is significantly different than a job ID. Paragraph 0044 relates to the setting of scanning parameters. However, a job ID is not disclose therein. Thus, neither of these paragraphs disclose the additional features recited in Applicants' claims 41 and 42.

Accordingly, claims 41 and 42 are submitted to be patentable over the asserted combination of references based upon their own recitations as well as based upon their dependence from a shown to be allowable base claim.

5. Claims 43, 44, 46 and 62 are not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that each of these claims depend (indirectly) upon and include the subject matter recited in independent claim 28. Accordingly, the obviousness rejection applied against these dependent claims is without an appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28 (as well as with respect to claims 41 and 61). Moreover, KITADA and TANIMOTO, in any proper combination, do not teach the combination of elements recited in these claims.

For example, claim 43 defines the job parameter with respect to features of the copying function, claim 44 defines the job parameter with respect to features of the printing function, and claims 46 and 62 define the job parameter with respect to features of the facsimile transmission function. In addressing these features, the Examiner directs attention to KITADA paragraphs 0023 and 0039 and particularly to lines 10 and 11 (of paragraph 0039).

However, paragraph 0023 does not deal with job parameters in any fashion. Paragraph 0039 deals with various parameters however, these parameters are limited to "scanning job parameters for the specific user ID". Thus, this paragraph is limited to "scanning" job parameters and contains no disclosure with respect to features of the copying function, features of the printing function or features on the facsimile transmission function.

Accordingly, claims 43, 44, 46, and 62, are submitted to be patentable over the asserted combination of references based upon their own respective recitations as well as based upon their dependence from a shown to be allowable base claim.

6. Claim 47 is not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claim 47 is dependant upon and includes the subject matter recited in independent claim 28. Accordingly, the obviousness rejection applied against claim 47 is without the appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 47.

For example, claim 47 recites that the information regarding the menu contains information regarding a maximum number of characters that can be

displayed on the display of the multifunction apparatus. In addressing this feature, the Examiner directs attention to KITADA paragraph 0033, lines 5-9. This paragraph refers to and describes a MFD profiler that sets a specific profile for a specific MFD via a profile screen on the scan server 40. The profile is described as including various items of information. However, none of these items of information relate to a maximum number of characters that can be displayed on the display of the multifunction apparatus.

Accordingly, claim 47 is submitted to be patentable over the asserted combination of references based upon its own recitations as well as based upon its dependence from a shown to be allowable base claim.

7. Claim 48 is not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claim 48 is dependent upon and includes the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claim 48 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 48.

For example, claim 48 defines the information regarding the menu as containing information regarding capabilities of the multifunction apparatus. In addressing this claim, the Examiner directed attention to paragraph 0033, lines 5-9. However, and as noted above, while this paragraph of KITADA relates to the profile screen, it does not relate to "capabilities of the multifunction apparatus". Rather, the profile includes an identification for the MFD, such as a serial number and various parameters used to configure the exchange of information between the scan server and the MFD. These parameters can relate to the authentication scheme used for each MFD, to the data format/ protocols used, to the e-mail server, to the fax server, and/or to the directory server. However, none of the profile items of information disclosed in paragraph 0033 relate to the capabilities of the multifunction apparatus.

Accordingly, claim 48 is submitted to be patentable over the asserted combination of references based on its own recitations as well as based upon its dependence from a shown to be allowable base claim.

8. Claim 60 is not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claim 60 is dependant upon and includes the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claim 60 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 60.

For example, claim 60 recites that the “another multifunction apparatus” transmits, to the multifunction apparatus, a job execution result, when the another multifunction apparatus completes the facsimile transmission. In addressing this claim, the Examiner directs attention to TANIMOTO, column 4, lines 48 through 61. However, this portion of TANIMOTO does not deal with the claimed subject matter of claim 60. Rather, this portion of TANIMOTO relates to notifying the managing PC of a recovery and the display of an indication that the fax server has an error. In the alternative, an indication can be displayed that the error has not occurred or has been cleared. However this portion of TANIMOTO contains no disclosure regarding transmitting a job execution result upon completion of facsimile transmission. Additionally, as noted above, TANIMOTO does not

even deal with, in the event of a detected error, facsimile transmission but with transmission via a LAN.

Accordingly, claim 60 is submitted to be patentable over the asserted combination of references based upon its own recitations as well as based upon its dependence from a shown to be allowable base claim.

9. Claim 61 is not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claim 61 is dependent upon and includes the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claim 61 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 61.

For example, claim 61 recites, that the server transmits, to the "another multifunction apparatus", the image data scanned by the multifunction apparatus with the job parameter. In addressing this aspect of Applicants' invention, the Examiner directs attention to KITADA, paragraph 0044. However, this paragraph deals with scanning parameters and does not deal with image data and a job parameter being transmitted by the server to the "another multifunction apparatus".

Accordingly, claim 61 is submitted to be patentable over the asserted combination of references based upon its own recitations as well as based upon its dependence from a shown to be allowable base claim.

10. Claims 63 is not disclosed, suggested or rendered obvious by KITADA in view of TANIMOTO

Applicants note that claim 63 is dependent upon (indirectly) and includes the subject matter recited in claim 28. Accordingly, the obviousness rejection applied against claim 63 is without appropriate evidentiary basis at least for the reasons set forth by Applicants with respect to claim 28. Moreover, KITADA and TANIMOTO, in any proper combination, does not teach the combination of elements recited in claim 63.

For example, claim 63 recites that the "another multifunction apparatus", transmits, to the receiving apparatus, the image data scanned by the multifunction apparatus based on the job parameter. In addressing this aspect of Applicants' invention, the Examiner directed Applicants attention to paragraph 0044 of KITADA. However, and as previously discussed, this paragraph deals with screen 400 which is used to set the scanning parameters. This paragraph has no relationship to a transmission, by the "another multifunction apparatus", to the receiving apparatus, of the image data scanned by the multi-function apparatus, based on the job parameter.

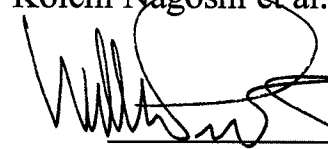
Accordingly, claim 63 is submitted to be patentable over the asserted combination of references based upon its own recitations as well as based upon its dependence from a shown to be allowable base claim.

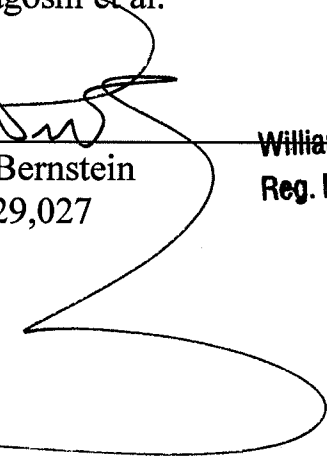
VIII. CONCLUSION

Each of claims 28, 29, 36-48 and 55-63 is submitted to be patentable for the reasons set forth herein. Specifically, the prior art of record has been shown to not teach, or suggest, the combination of features recited in Applicants' claims and is not combinable in the manner proposed by the Examiner. Moreover, even if the prior art references were considered to be properly combined, Applicants have shown, that the combination fails to disclose or suggest the particular combination of features recited in Applicants' claims 28, 29, 36-48 and 55-63. Accordingly, Applicants respectfully request that the Board reverse the decision of the Examiner to reject the above noted claims and return the application to the Examiner for further action consistent with such reversal.

Accordingly, Applicants respectfully submit that each and every pending claim of the present application meets the conditions for patentability and that the present application, and each claim pending therein, is allowable over the prior art of record.

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IX. Claims Appendix

28. A multifunction apparatus having at least a scanning function and not having a facsimile transmission function, the multifunction apparatus connected with a server via a network, the server storing information regarding a menu, the menu being displayable on the multifunction apparatus, the multifunction apparatus comprising:

a scanner configured to scan a document;

a panel configured to display a menu representing functions of the multifunction apparatus; and

a controller configured to communicate with the server, to receive the information regarding the menu from the server, and to display a menu on the panel based on the information regarding the menu received from the server,

the controller being further configured to send, to the server, based on the information regarding the menu, scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission, when a predetermined menu

indicating a facsimile transmission function is displayed on the panel of the multifunction apparatus, the information regarding the menu including the predetermined menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the predetermined menu, whereby the server transmits, to the another multifunction apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another multifunction apparatus.

29. The multifunction apparatus according to claim 28, wherein the controller utilizes a scanning function to scan a document, when the facsimile transmission is selected on the menu.

36. The multifunction apparatus according to claim 28, wherein the information regarding the menu is utilized for the multifunction apparatus and also for another multifunction apparatus.

37. The multifunction apparatus according to claim 28, wherein the information regarding the menu is utilized only for the multifunction apparatus.

38. The multifunction apparatus according to claim 28, wherein the information regarding the menu is utilized for at least one of a plurality of functions of the multifunction apparatus.

39. The multifunction apparatus according to claim 38, wherein at least one of a plurality of functions of the multifunction apparatus is an operation customized for a particular user.

40. The multifunction apparatus according to claim 28, wherein the information regarding the menu contains a menu item name, the menu item name indicating a job that the multifunction apparatus performs.

41. The multifunction apparatus according to claim 28, wherein the information regarding the menu contains a menu item name, a job-ID and a job parameter.

42. The multifunction apparatus according to claim 41, wherein the multifunction apparatus additionally has at least one of a scanning, and a printing, and the job ID includes at least one of copying, printing, scanning and fax transmission.

43. The multifunction apparatus according to claim 41, wherein the job parameter includes at least one of an image type and paper size for copying.

44. The multifunction apparatus according to claim 41, wherein the job parameter includes at least one of an image type, paper size and resolution for printing.

45. The multifunction apparatus according to claim 41, wherein the job parameter includes at least one of an image type, paper size, resolution and file format for scanning.

46. The multifunction apparatus according to claim 41, wherein the job parameter includes at least one of an image type, paper size, resolution and file format for facsimile transmission.

47. The server according to claim 28, wherein the information regarding the menu contains information regarding a maximum number of characters that can be displayed on the display of the multifunction apparatus.

48. The server according to claim 28, wherein the information regarding the menu contains information regarding capabilities of the multifunction apparatus.

55. A method for controlling a multifunction apparatus, the multifunction apparatus having at least a scanning function and not having a facsimile transmission function, the multifunction apparatus being connected with a server via a network, the server storing information regarding a menu, the menu being displayable on the multifunction apparatus, the multifunction apparatus having a scanner that scans a document, and a panel that displays a menu representing functions of the multifunction apparatus, the method comprising:

communicating with the server, to receive the information regarding the menu from the server:

displaying a menu on the panel based on the information regarding the menu received from the server; and

sending, to the server, based on the information regarding the menu, scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission, when a predetermined menu indicating a facsimile transmission function is displayed on the panel of the multifunction apparatus, the information regarding the menu including the predetermined

menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the predetermined menu, the server transmits, to the another multifunction apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another multifunction apparatus.

56. The method according to claim 55, wherein the information regarding the menu is utilized for the multifunction apparatus and also for another multifunction apparatus.

57. The method according to claim 55, wherein the information regarding the menu is utilized only for the multifunction apparatus.

58. The method according to claim 55, wherein the information regarding the menu is utilized for at least one of a plurality of functions of the multifunction apparatus.

59. The method according to claim 58, wherein at least one of a plurality of functions of the multifunction apparatus is an operation customized for a particular user.

60. The multifunction apparatus according to claim 28, wherein the another multifunction apparatus transmits, to the multifunction apparatus, a job execution result, when the another multifunction apparatus completes the facsimile transmission.

61. The multifunction apparatus according to claim 28, wherein when the controller sends, to the server, the scanned image data, the controller sends to the server, a job parameter, and the server transmits to the another multifunction apparatus, the image data scanned by the multifunction apparatus with the job parameter.

62. The multifunction apparatus according to claims 61, wherein the job parameter contains at least one of paper size, and resolution for facsimile transmission.

63. The multifunction apparatus according to claim 61, wherein the another multifunction apparatus transmits, to the receiving apparatus, the image data scanned by the multifunction apparatus, based on the job parameter.

X. Evidence Appendix

None.

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Appeal Brief Under 37 C.F.R. § 41.37(d)

XI. Related Proceedings Appendix

None.